



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Secrecy and License to Export

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice of information collection; request for comment.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on the extension and revision of an existing information collection: 0651-0034 Secrecy and License to Export. The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

DATES: To ensure consideration, comments regarding this information collection must be received on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information.

- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Justin Isaac, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Parikha Mehta, Senior Legal Advisor, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-3248; or by

email at parikha.mehta@uspto.gov with “0651-0034 comment” in the subject line. Additional information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

In the interest of national security, patent laws and regulations place certain limitations on the disclosure of information contained in patents and patent applications and on the filing of applications for patents in foreign countries.

A. Secrecy Orders

Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent is, in the opinion of the head of an interested Government agency, determined to be detrimental to national security, the Commissioner for Patents at the United States Patent and Trademark Office (USPTO) must issue a secrecy order and withhold the publication of a patent application and the grant of a patent for such period as the national interest requires. A patent will not be issued on the application, nor will the application be published, as long as the secrecy order is in force. If a secrecy order is applied to an international application, the application will not be forwarded to the International Bureau as long as the secrecy order is in effect.

The Commissioner for Patents can issue three types of secrecy orders, each of a different scope. The first type, Secrecy Order and Permit for Foreign Filing in Certain Countries, is intended to permit the widest utilization of the technical data in the patent application while still controlling any publication or disclosure that would result in an unlawful exportation. The second type, the Secrecy Order and Permit for Disclosing Classified Information, is to treat classified technical data presented in a patent application in the same manner as any other classified material. The third type of secrecy

order is used where the other types of orders do not apply, including orders issued by direction of agencies other than the Department of Defense.

Under the provision of 35 U.S.C. 181, a secrecy order remains in effect for a period of one year from its date of issuance. A secrecy order may be renewed for additional periods of not more than one year upon notice by a government agency that the national interest continues to so require. The applicant is notified of such renewal.

When the USPTO places a secrecy order on a patent application, the regulations authorize the applicant to petition the USPTO for permits to allow disclosure, modification, or rescission of the secrecy order, or to obtain a general or group permit. In each of these circumstances, the petition is forwarded to the appropriate defense agency for decision. Also, the Commissioner for Patents at the USPTO may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the disclosure of the invention is no longer deemed detrimental to the national security.

Unless expressly ordered otherwise, action on the application and prosecution by the applicant will proceed during the time the application is under secrecy order to the point indicated in 37 CFR 5.3. See the Manual of Patent Examining Procedure (MPEP) Section 130 (9th ed., rev. 10.2019, June 2020). For example, prosecution of a national application under secrecy order may proceed only to the point where it is found to be in condition for allowance. See 37 CFR 5.3(c). Prosecution of international applications under secrecy order, on the other hand, will proceed only to the point before record and search copies would be transmitted to the international authorities or the applicant. See 37 CFR 5.3(d). National applications under secrecy order that come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. See 37 CFR 5.3(a). Appeals in such cases must be completed by the applicant. Unless specifically ordered

by the Commissioner for Patents, these appeals will not be set for hearing until the secrecy order is removed. See *id.*

B. Foreign Filing License

In addition, this information collection covers information gathered with respect to foreign filing licenses. The filing of a patent application is considered a request for a foreign filing license. However, in some instances an applicant may need a license for filing patent applications in foreign countries prior to a filing in the USPTO or sooner than the anticipated licensing of a pending patent application.

For such circumstances, this information collection covers petitions for a foreign filing license either with or without a corresponding United States application. In addition, this information collection covers petitions to change the scope of a license and petitions for a retroactive license for instances when a patent application is filed through error in a foreign country without the appropriate filing license.

This information collection includes the information needed by the USPTO to review the various types of petitions regarding secrecy orders and foreign filing licenses. This collection of information is required by 35 U.S.C. 181-183 and 184-186 and administered by the USPTO through 37 CFR 5.1-5.5, 5.11-5.15, and 5.18-5.25.

II. Method of Collection

Electronically via the USPTO's patent electronic filing system, by mail, or by hand delivery to the USPTO.

III. Data

OMB Control Number: 0651-0034.

Forms: None.

Type of Review: Extension and revision of a currently approved information collection.

Affected Public: Private sector; individuals or households.

Respondent's Obligation: Required to obtain or retain benefits.

Estimated Number of Annual Respondents: 7,524 respondents.

Estimated Number of Annual Responses: 7,524 responses.

Estimated Time per Response: The USPTO estimates that the responses in this information collection will take the public approximately between 30 minutes (0.5 hours) and 4 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed item to the USPTO.

Estimated Total Annual Respondent Burden Hours: 4,503 hours.

Estimated Total Annual Respondent Hourly Cost Burden: \$1,958,805.

Table 1: Total Burden Hours and Hourly Costs to Private Sector Respondents

Item No.	Item	Estimated Annual Respondents (a)	Responses per Respondent (b)	Estimated Annual Responses (a) X (b) = (c)	Estimated Time For Response (hours) (d)	Estimated Burden (hour/year) (c) x (d) = (e)	Rate ¹ (\$/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
1	Petition for Rescission of Secrecy Order	10	1	10	3	30	\$435	\$13,050
2	Petition to Disclose or Modification of Secrecy Order	10	1	10	2	20	\$435	\$8,700
3	Petition for General and Group Permits	1	1	1	1	1	\$435	\$435
4	Petition for Expedited Handling of License (no corresponding application)	6,860	1	6,860	0.5	3,430	\$435	\$1,492,050
5	Petition for Expedited Handling of License (corresponding U.S. application)	294	1	294	0.5	147	\$435	\$63,945
6	Petition for Changing Scope of License	3	1	3	0.5	2	\$435	\$870
7	Petition for Retroactive License	196	1	196	4	784	\$435	\$341,040
	Totals	7,374	---	7,374	---	4,414	---	\$1,920,090

Table 2: Total Burden Hours and Hourly Costs to Individual and Household Respondents

¹ 2021 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); pg. F-27. The USPTO uses the average billing rate for intellectual property attorneys in private firms which is \$435 per hour. (<https://www.aipla.org/home/news-publications/economic-survey>).

Item No.	Item	Estimated Annual Respondents (a)	Responses per Respondent (b)	Estimated Annual Responses (a) X (b) = (c)	Estimated Time For Response (hours) (d)	Estimated Burden (hour/year) (c) x (d) = (e)	Rate ² (\$/hour) (f)	Estimated Annual Respondent Cost Burden (e) x (f) = (g)
4	Petition for Expedited Handling of License (no corresponding application)	140	1	140	0.5	70	\$435	\$30,450
5	Petition for Expedited Handling of License (corresponding U.S. application)	6	1	6	0.5	3	\$435	\$1,305
7	Petition for Retroactive License	4	1	4	4	16	\$435	\$6,960
	Totals	150	---	150	---	89	---	\$38,715

Estimated Total Annual Respondent Non-hourly Cost Burden: \$1,477,829.

There are no maintenance costs, capital start-up costs, or recordkeeping costs associated with this information collection. However, the USPTO estimates that the total annual (non-hour) cost burden for this information collection, in the form of filing fees (\$1,477,135) and postage (\$694), is \$1,477,829.

Filing Fees

The items with filing fees are listed in the table below.

Table 3: Filing Fees

IC No.	Item	Responses (a)	Filing Fee (\$) (b)	Total Non-Hour Cost Burden (a) x (b) (c)
4	Petition for Expedited Handling of License (no corresponding application) (undiscounted entity)	5,600	\$220	\$1,232,000
4	Petition for Expedited Handling of License (no corresponding application) (small entity)	1,260	\$110	\$138,600
4	Petition for Expedited Handling of License (no corresponding application) (micro entity)	140	\$55	\$7,700
5	Petition for Expedited Handling of License (corresponding U.S. application) (undiscounted entity)	240	\$220	\$52,800
5	Petition for Expedited Handling of License (corresponding U.S. application) (small entity)	54	\$110	\$5,940

² Ibid.

IC No.	Item	Responses (a)	Filing Fee (\$) (b)	Total Non-Hour Cost Burden (a) x (b) (c)
5	Petition for Expedited Handling of License (corresponding U.S. application) (micro entity)	6	\$55	\$330
6	Petition for Changing Scope of License (undiscounted entity)	1	\$220	\$220
6	Petition for Changing Scope of License (small entity)	1	\$110	\$110
6	Petition for Changing Scope of License (micro entity)	1	\$55	\$55
7	Petition for Retroactive License (undiscounted entity)	160	\$220	\$35,200
7	Petition for Retroactive License (small entity)	36	\$110	\$3,960
7	Petition for Retroactive License (micro entity)	4	\$55	\$220
	Totals	7,503	- - -	\$1,477,135

Postage

The USPTO estimates that 99% of the petitions in this information collection are submitted electronically, by facsimile, or hand carried because of the quick turnaround required, and only 1% of the 7,524 petitions will be submitted in the mail. The USPTO estimates that the average postage cost for a mailed submission, using a Priority Mail 2-day flat rate legal envelope, will be \$9.25 and that approximately 75 submissions will be mailed to the USPTO per year. Therefore, the USPTO estimates that postage costs in this collection will be \$694.

IV. Request for Comments

The USPTO is soliciting public comments to:

- (a) Evaluate whether the collection of information is necessary for the proper performance of the functions of the Agency, including whether the information will have practical utility;
- (b) Evaluate the accuracy of the Agency's estimate of the burden of the collection of information, including the validity of the methodology and assumptions used;

- (c) Enhance the quality, utility, and clarity of the information to be collected; and
- (d) Minimize the burden of the collection of information on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, phone number, email address, or other personally identifiable information (PII) in a comment, be aware that the entire comment—including PII—may be made publicly available at any time. While you may ask in your comment to withhold PII from public view, USPTO cannot guarantee that it will be able to do so.

Justin Isaac,

Information Collections Officer,

Office of the Chief Administrative Officer,

United States Patent and Trademark Office.

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